

REMARKS

The applicant notes that the Examiner has issued a non-final Office Action, thereby withdrawing the under final status of the application.

Claims 1-60 are pending. Claims 58-60 have been added, and claims 2-4 have been canceled without prejudice or disclaimer. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-8, 10-16, 19-22, and 24-57 stand rejected under 35 U.S.C. § 103(a) or 103 as being unpatentable over www.inventnet.com (www.inventnet.com, retrieved from Internet Archive WayBack Machine www.archive.org, date range: 12/3/1998-2/9/1999) ("Inventnet"), in view of U.S. Patent No. 5,175,681, Iwai et al. ("Iwai"). Further, claims 9, 17, 18, and 23 stand rejected under 35 USC 103(a) or (103) as being unpatentable over Inventnet and Iwai, further in view of Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine www.archive.org, date range 2/24/1998-2/18/1999). For the reasons including, *inter alia*, those discussed below, each of independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 is patentable over the applied references. Claims dependent therefrom are similarly patentable. The Examiner is respectfully requested to reconsider and withdraw the rejections for the reasons given below.

Claims 1-3, 5-8, 10-12, 14-16, 20-22, 24-34, 37, 38, 40-48 and 50-57 stand rejected under 35 USC 103(a) as being unpatentable over Inventnet in view of Iwai.

To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. In re Deuel, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the Examiner fails to establish a *prima facie* case of obviousness, Appellant has no burden to rebut the rejection of obviousness with evidence. In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more Appellant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Of independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, the Office Action only addresses claim 1. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 197). The Examiner cannot disregard claim limitations.

The Office Action fails to consider the specific limitations of independent claim 5 (or the other remaining independent claims). Paragraphs 5-9 of the third Office Action mention only the limitations of claim 1. Nevertheless, the rejection of independent claims 5, 15, 22, 25, 33, 41, 44, 52 and 56 is made in common with the rejection of claim 1, despite these claims reciting different limitations. Consequently, the Office Action fails to consider whether InventNet or Iwai teach or suggest the specific limitations of claim 5, 15, 22, 25, 33, 41, 44, 52 and 56, and

fails to specify any particular portion of a reference to support the rejection. For this additional reason, the Office Action fails to present a prima facie case of obviousness with respect to the limitations of claim 5, 15, 22, 25, 33, 41, 44, 52 and 56.

Appellant provides herein a selection of some examples of limitations in the claims, as amended, which are neither taught nor suggested by Inventnet and/or Iwai, alone or in combination. The Office Action admits that Inventnet fails to suggest or teaches that the form documents are “corresponding to target jurisdiction and associate specifications”, or that they are distributed... as claimed.

With respect to claim 1, neither Inventnet nor Iwai, alone or in combination, teaches, for example:

- That the form documents are “corresponding to target jurisdiction and associate specifications”
- that “the form documents include empty fields defined for completion of matter-specific information.”
- that the forms are distributed “to an originating filer”
- that filing documents are received from the originating filer
- that filing documents (received from the originating filer) are completed with matter-specific information from the originating filer
- the step of determining respective associates for receipt of the filing documents
- the step of determining respective associates for receipt of the filing documents
- the step of forwarding the filing documents to the respective associates

Recognizing the deficiencies of Inventnet, the Office Action takes official notice that “all necessary form documents were available electronically”, citing “uspto.gov, epo.co.” The finding of official notice is respectfully traversed. An assertion of official notice of facts where the allegedly well known facts are not capable of instant and unquestionable demonstration is not appropriate. An assertion of basic knowledge that is not based on any evidence in the record lacks substantial evidence support, and will not support an obviousness rejection. In re Zurko, 258 F.2d 1379, 1385 (Fed. Cir. 2001). It appears that the Examiner is erroneously attempting to notice the “plurality of form documents corresponding to target jurisdiction and associate specifications, wherein the form documents include empty fields defined for completion of matter-specific information” (claim 1, as amended), somehow relying on the USPTO web site (in its entirety) and some unknown web site at www.epo.co. In any event, it is highly doubtful that the governmental entity would offer documents corresponding to, at least, particular associate specifications in addition to target jurisdiction specifications. Applicant therefore requests that the Examiner provide clarification, a prior art reference or an affidavit under 37 C.F.R. 1.104(d)(2) to support the rejection.

Building from the unsupported official notice, the Examiner asserts that it would have been obvious to correlate the forms with associates. To the contrary, where the forms are not associate-specific, there is no motivation to correlate forms with associates.

The Office Action admits that Inventnet “fails to expressly disclose wherein the form documents are corresponding to target jurisdiction and associate specifications; and distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates.” (Office Action, ¶ 5). Recognizing that Inventnet fails to teach and/or suggest the invention as claimed, Iwai is cited to remedy the deficiencies.

Nevertheless, Iwai fails to remedy such deficiencies. For example, the country rules of Iwai (Col. 3, lines 21-48) do not teach or suggest “a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications.” Iwai also fails to teach or suggest “distributing” such registered documents “to an originating filer” to prepare documents for “filing by respective ones of the associates” that are registered. As another example, Iwai further does not teach or suggest registering, for associates, a target jurisdiction and such form documents.

Hence, Inventnet and Iwai, alone or in combination, fail to teach or suggest the combination of features recited in the claim 1, when considered as a whole.

Furthermore, Inventnet and/or Iwai operate in a fundamentally different way than the claimed invention. Specifically, neither Inventnet nor Iwai teach or even suggest, let alone disclose, anything concerning intellectual property documents suitable for filing by particular associates. Moreover, neither Inventnet nor Iwai teach or suggest a relation between a registered associate, and form documents corresponding to the associate specifications as well as the target jurisdiction. Inventnet and Iwai fail to teach or suggest registering a plurality of form documents corresponding to target jurisdiction and associate specifications. The Office Action takes notice of, perhaps, official USPTO documents as disclosing this limitation, however, Inventnet and Iwai is clearly deficient considering the invention as claimed as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

With regard to independent claim 5, InventNet neither teaches nor suggests, for example, “an intellectual property filing portal coupled by the network to the originating node and at least a portion of the target nodes”, where the portal is “responsive to a selection at the originating node of at least one target jurisdiction and at least one associate corresponding thereto,” and

“supplying the originating node with the particularized requirements of the selected at least one target jurisdiction and at least one associate,” where the portal, further responsive to “receipt ... of one or more intellectual property filings prepared in accordance with the particularized requirements ..., supplying ones of the target nodes” with intellectual property filings “for filing by respective ones of the selected at least one associate in respective ones of the selected at least one target jurisdiction” (independent claim 5).

Furthermore, the Office Action fails to consider the specific limitations of independent claim 5 (or the other remaining independent claims). Paragraphs 4-9 of the Office Action mention only the limitations of claim 1. Nevertheless, the rejection of claim 5 (and all other independent claims 15, 22, 25, 33, 41, 44, 52 and 56) is made in common with the rejection of claim 1, despite these claims reciting different limitations. Consequently, the Office Action fails to consider whether InventNet or Iwai teach or suggest the specific limitations of claim 5 and fails to specify any particular portion of a reference to support the rejection. For this additional reason, the Office Action fails to present a prima facie case of obviousness with respect to the limitations of claim 5 (and all other independent claims 15, 22, 25, 33, 41, 44, 52 and 56).

Further with regard to independent claim 15, InventNet and/or Iwai, alone or in combination, neither teach nor suggest, for example, “responsive to a selection by a user of at least one target jurisdiction and at least one associate corresponding thereto, supplying the user ... with a computer readable encoding of one or more form documents, wherein the form documents are specific to the at least one target jurisdiction and at least one associate” or “receiving from the user ... one or more documents suitable for filing ... and forwarding same to the selected at least one associate” (independent claim 15).

Moreover, further in connection with independent claim 22, InventNet and Iwai, alone and/or in combination, fail to teach or suggest, for example, “receiving ... a transmission from a user, having at least one selection of two or more target jurisdictions and corresponding one or more associates for an intellectual property filing,” “supplying a transmission ... of one or more target jurisdiction and associate specific documents for completion,” “receiving ... completed one or more target jurisdiction and associate-specific documents,” and “forwarding ... respective ones of the target jurisdiction and associate-specific documents, to each of the selected one or more associates” (independent claim 22).

With regard to independent claim 25, InventNet and Iwai, alone or in combination, fail to teach or suggest, for example, responsive to a selected “target jurisdiction”, “obtaining a computer readable encoding of one or more form documents” wherein the documents are “specific to the target jurisdiction and to a respective associate therefore,” and “supplying at least a portion of a set of filing documents” in accordance with such form documents (independent claim 25). Moreover, the Office Action fails to consider the specific language of independent claim 25, and therefore fails to present a *prima facie* case of obviousness.

With regard to independent claim 33, the Office Action fails to make a *prima facie* case of obviousness because the specific limitations of claim 33 are not considered. Arguments made with respect to claim 5 are incorporated herein.

Moreover, InventNet and/or Iwai, alone or in combination, nevertheless fail to teach or suggest various elements recited in independent claim 33, for example, selecting one or more target jurisdiction, and for each selected target jurisdiction, selecting attorneys; and “for each selected target jurisdiction, transforming a computer readable encoding of intellectual property application data to a format appropriate for filing ... and electronically transmitting the

transformed computer readable encoding to an attorney or agent for filing in the selected target jurisdiction” (independent claim 33).

Further with regard to independent claim 41, InventNet and/or Iwai fail to teach or suggest, for example, receiving “at a target computer” “a selection of one or more target jurisdictions,” and responsive to the receipt of the selection, “supplying, from the target computer ... a computer readable encoding of filing requirements for the selected one or more target jurisdictions” (independent claim 41).

The Office Action failed to consider the limitations of independent claim 44 separate from claim 1. Consequently, and for the reasons given above in connection with claim 5, the Office Action fails to state a prima facie case of obviousness.

Moreover, in connection with claim 44 concerning “an information system for preparing intellectual property filings for at least one target in accordance with requirements thereof” and claims dependent therefrom, InventNet and/or Iwai, alone or in combination, fails to teach or suggest, for example, “a selection facility by which a user thereof selects the at least one target”, an interface to application data, an interface to target requirement data, and a filing preparation facility to “transform the intellectual property application data “into a target specific intellectual property application filing format ... in accordance with the target requirement data,” and “preparing at least one additional document in accordance with the intellectual property application and suitable for filing in accordance with target requirement data” (independent claim 44).

In connection with independent claim 52, the Office Action fails to consider the limitations in this claim and hence fails to state a case of prima facie obviousness. Nevertheless, InventNet and/or Iwai fail to teach or suggest, for example, selection code to “select one or more

target jurisdictions and respective associates”, retrieval code to retrieve “target jurisdiction- and associate- specific filing requirements,” document preparation code to prepare “target jurisdiction- and associate-specific documents”, and filing initiate code to transmit “the prepared documents” (independent claim 52).

Concerning independent claim 54, InventNet and/or Iwai, alone or in combination, fail to teach or suggest, for example, a method of making a computer readable encoding of “target jurisdiction- and associate-specific form documents”, including “maintaining a data store of target jurisdiction- and associate-specific form documents” for transacting an intellectual property filing in the target jurisdiction(s), encoding “an enumeration, for transmission to a computer, of at least a subset of the target jurisdictions and respective of the associates therefore”, and receiving a selection of target jurisdiction(s) and respective associates, retrieving form documents based on the selection, and encoding the retrieved “target jurisdiction- and associate-specific form documents” (independent claim 54).

Similarly, the Office Action fails to state a prima facie case of obviousness with respect to independent claim 56. However, InventNet and/or Iwai, alone or in combination, fails to teach or suggest, for example, “means for selecting one or more target jurisdictions and respective associates,” and “means for transmitting a technical document and respective of the completed form documents, for filing by the elected associates (independent claim 56).

Claims dependent from independent claim 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, as may be amended, are deemed to be allowable for the reasons given above, and because of further limitations. The discussion of claim limitations in this regard, from prior Office Action responses, is expressly incorporated herein.

Not only do the references, individually or combined, fail to teach or suggest various claim limitations, but also there is no suggestion or motivation to combine the references. “There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” In re Oetiker, 977 F.2d 1443, 24 USPQ.2d 1443 (Fed. Cir. 1992). Moreover, to establish a prima facie case of obviousness, “it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention.” In re Levengood, 28 USPQ.2d 1300, 1301 (Bd. Pat. App. 1993).

Failure to point to specific information that teaches or suggests the combination claimed cannot support a conclusion of obviousness. In re Dembiczak, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). “Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ.2d 1313, 1317 (Fed. Cir. 2000). See also Crown Operations Int’l Ltd. V. Solutia Ina., 289 F.3d 1367, 1376, 62 USPQ.2d 1917 (Fed Cir. 2002) (“there must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, ... to look to particular elements, and to combine them as combined by the inventor”).

The Office Action provides no motivation to combine an Attorney directory with a country filing rules system, other than the conclusory statement in paragraph 9 of the Office Action that the combination would be made “for the advantage of operating an information service to facilitate preparation of intellectual property documents with the ability to increase the efficiency/effectiveness of the system by providing the use with automated tools to complete a

number of intellectual property filings.” One cannot glean from Inventnet a motivation to combine its patent attorney directory or other materials with, e.g., Iwai’s country rules. Nor can one glean from Iwai a motivation to offer inventor group materials of any type.

In determining whether a suggestion can be fairly gleaned from the prior art, one must consider the full field of the invention, “including that which might lead away from the claimed invention.” In re Dow Chemical, 837 F.2d 469, 473, 5 USPQ.2d 1529, 1531 (Fed. Cir. 1988). Here, Inventnet instructs its users themselves to use a patent attorney to prepare the necessary documents (“Patenting Help” page screen).

Moreover, assuming *arguendo* that it may have been possible to access both Iwai and Inventnet over the Internet, (although Applicant does not admit Iwai was accessible over the Internet), that in itself provides no motivation to combine the references as proposed by the Examiner. To the contrary, where the prior art does not suggest the combination or convey a reasonable expectation of success of making it, there is no *prima facie* case of obviousness. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991).

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449 230 USPQ 416, 420 (Fed. Cir. 1986). Here, because there is no motivation for the combination of Inventnet and Iwai, and even the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention, the Examiner has failed to establish obviousness generally, as well as the requisite *prima facie* case. Accordingly, Appellant is not presenting, at this time, objective evidence tending to support a conclusion of non-obvious, since no such evidence is necessary at this time.

Assuming *arguendo* the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of Iwai and Inventnet still fail to provide an ability for users to select from a list of registered associates the target jurisdiction and associate-specific form documents, and have the associate file for the intellectual property rights.

The claimed subject matter “as a whole” must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., *supra*. Here, the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention.

Assuming *arguendo* a motivation to combine the two references, the proposed modification would appear to change the principle of operation of either Inventnet or Iwai, or both. Inventnet, an inventor’s network, does not appear to be appropriate for offering its users a system for industrial property rights’ rule data for countries. Indeed, InventNet recommends using an attorney for filing. On the other hand, Iwai is not a “plurality of form documents corresponding to target jurisdiction and associate specifications”, registered for each of plural associates. The proposed combination would modify Iwai further to accommodate filable forms and different associate specifications, for example. Hence, the proposed combination would appear to require some basic changes to the fundamental principles upon which Inventnet and Iwai operate in order for each to accommodate the other in the manner proposed by the Examiner.

Moreover, it appears that the Examiner is impermissibly relying to a great degree on hindsight, including error-prone recollections of governmental web sites and Applicant’s own disclosure. “[I]t is impermissible to use the claimed invention as an instruction manual or

‘template’ to piece together the teaching of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992).

The fact that an invention in hindsight may appear to be simple, does not mean the invention is not patentable. As stated by the Federal Circuit:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. § 103(a) over Evans. Moreover, because the rejections of claims 3 and 10 rely upon the foregoing, we also conclude that the Board did not make out a proper prima facie case of obviousness in rejecting those claims under 35 U.S.C. § 103(a).

In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000).

For at least these reasons, the combination of features recited in independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56 when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 or 56, but also because of additional features they recite. Examples of some of these features were discussed previously.

For all the reasons advanced above, Applicant respectfully requests that the rejection of claims 1-57 be reconsidered and withdrawn.

New claims 58-60 are added to define one or more embodiments of the present invention.

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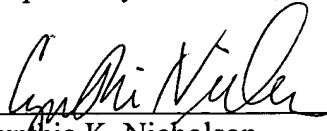
In view of the forgoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

A request for extension of time is enclosed.

Please note the enclosed change of correspondence address.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,


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